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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER				
NAQI, SHARICK				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/530,494

**Applicant(s)**

SUCH ET AL.

**Examiner**

SHARICK NAQI

**Art Unit**

3769

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 April 2009.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 and 11-21 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-9 and 11-21 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

The Examiner acknowledges the amendment filed on April 27, 2009.

#### Note to Applicant Regarding Claim Interpretation

The word "for" in the claim(s) may be interpreted as intended use. Intended use/functional language does not require that reference specifically teach the intended use of the element. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-9 and 11-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1, 2, 3, 6, 7, 8 and 21 positively recite limitations that overlap statutory classes. In this case, the applicant has positively recited *a method and an apparatus* in the same claim. More specifically, "a sensor picking up a first signal ... forwarding the first signal ... generating a second signal ... transmitting the second signal ... decoding the second signal ... making the system enter into a second mode" in claim 1, "electrode transmitting the second signal"

in claim 2, "an RF-link establishing a wireless communication" in claim 3, "a control unit controlling the personal monitoring system ... and superimposing the trigger signal" in claim 6, "the electrode being transmitting the trigger signal" in claim 7, "a user interface operating the control unit", and "the control unit generating ... transmitting ... decoding ... initiating are method steps written in a system or apparatus type claim. See MPEP 2173.05(p) 11. Dependent claims are rejected as being dependent on a rejected claim.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 11 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 11 states, "wherein upon receipt of the trigger signal, the control unit performs a dedicated wakeup sequence." However, the Examiner is unable to find support in the original disclosure for this limitation. Claim 12 is rejected based on its dependence on claim 11.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 and 11-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant has positively recited *a method and an apparatus* in the same claim. More specifically, "a sensor picking up a first signal ... forwarding the first signal ... generating a second signal ... transmitting the second signal ... decoding the second signal ... making the system enter into a second mode" in claim 1, "electrode transmitting the second signal" in claim 2, "an RF-link establishing a wireless communication" in claim 3, "a control unit controlling the personal monitoring system ... and superimposing the trigger signal" in claim 6, "the electrode being transmitting the trigger signal" in claim 7, "a user interface operating the control unit", and "the control unit generating ... transmitting ... decoding ... initiating are method steps written in a system or apparatus type claim. Method steps are not structural limitations therefore it is unclear to the Examiner how much patentable weight, should be given to these non-structural limitations in the system/apparatus claims, i.e. how to interpret these limitations. As such the claims are indefinite.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-2, 4-8, 11, 13, 16, 18 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Funke US Patent No. 4, 987,897.**

The claims are rejected on substantially the same basis as the previous office action.

**Claims 1-9, 11-12, 16-17 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Rode et al. US Patent No. 6,315,719 (hereinafter Rode).**

The claims are rejected on substantially the same basis as the previous office action.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 14-15 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Funke as applied to claims 13 and 18 above.**

Claims 14-15 and 19-20 are rejected on substantially the same basis as the previous office action.

#### ***Response to Arguments***

Applicant's arguments filed April 27, 2009 have been fully considered but they are not persuasive.

Applicant argues that there is support for the limitation in claim 11 "wherein upon receipt of the trigger signal, the control unit performs a dedicated wakeup sequence" on page 2 of the original disclosure. Examiner disagrees because the original disclosure does not disclose that the control unit performs the dedicated wake up sequence upon receipt of the trigger signal.

Applicant argues that the amendment overcomes the applied prior art of Funke and Rode. The Examiner disagrees with the Applicant and maintains the prior art rejection because the Applicants amendments have provided negligible structural differences between the present and the previous claimed invention. Applicant has not added further limiting structure to the claims because "a sensor picking up a first signal ... forwarding the first signal ... generating a second signal ... transmitting the second

signal ... decoding the second signal ... making the system enter into a second mode" in claim 1, "electrode transmitting the second signal" in claim 2, "an RF-link establishing a wireless communication" in claim 3, "a control unit controlling the personal monitoring system ... and superimposing the trigger signal" in claim 6, "the electrode being transmitting the trigger signal" in claim 7, "a user interface operating the control unit", and "the control unit generating ... transmitting ... decoding ... initiating are only method steps and not structural limitations.

It is the Examiner's position that the Funke and Rode references reject the structural limitations of the claimed invention.

**The Applicant is invited to request an interview to discuss suggestions to overcome the applied prior art.**

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the



shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHARICK NAQI whose telephone number is (571)272-3041. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry M. Johnson III can be reached on 571-272-4768. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner, Art Unit 3769

/Michael C. Astorino/

Primary Examiner, Art Unit 3769

July 29, 2009